

REMARKS

Claims 1-35 are pending in the application.

Claims 10, 25, 27, 29-33, and 35 are rejected.

Claims 1, 3, 5, 6, 8, 10-12, 14, 16-18, 21, 27, 29-33, and 35 are objected to.

Claims 2, 4, 7, 9, 13, 15, 19, 20, 22-24, 26, 28, and 34 are withdrawn, as being directed to non-elected subject matter.

Claims 1, 3, 5, 6, 8, 10, 17, and 18 are currently amended.

Original Claims 2, 4, 7, 9, 11, 13, 15, 19, 20, and 22-35 are cancelled.

Claim 36 is newly added.

Original Claims 12, 14, 16, and 21, amended Claims 1, 3, 5, 6, 8, 10, 17, and 18, and new Claim 36 are directed to compounds, pharmaceutical compositions comprising the compounds, and methods of treating osteoarthritis, and would be all of the claims remaining in the application if the instant amendment is entered. No new matter is added.

Discussion of Amendments to the Claims

Claims 1, 3, 5, 6, 8, 10, 17, and 18 are currently amended. Support for the amendments is found in the specification and claims as filed. For example, support for amended Claims 1, 3, 5, 6, 8, 10, 17, and 18 is found in original Claims 1, 3, 5, 6, 8, 10, 17, and 18, respectively, page 3, at lines 5-6, and Examples 8 and 14.2. Support for new Claim 36 is found in original Claim 11, on page 56, at lines 24-25, and original Claim 31, on page 67, at lines 6-7.

Applicants note that in Claims 5 and 10, the possible values for the group "n" of the compound of Formula V have been limited to 1, while the possible values for the group "n" of the groups R⁴ and R⁵ have been maintained at 0 to 6. This limitation was added because if Claims 5 and 10 had been amended only in the definition of "Ar," the subject matter of the invention of Group I therein

would have otherwise been identical to the subject matter of amended Claims 3 and 5, respectively. Support is found as referenced above.

Further, Claims 2, 4, 7, 9, 11, 13, 15, 19, 20, and 22-35 are cancelled without prejudice to filing a continuation or divisional application to prosecute them. The only species of Claims 11 and 31 that falls within the invention of Group I is now claimed in new Claim 36.

Restriction under 35 U.S.C. § 121

Regarding items 1 to 3 of the above-referenced Office Action mailed April 18, 2003, Applicants hereby affirm provisional election of the invention of Group I. Applicants withdraw the traverse.

Claim Rejection - 35 U.S.C. § 112, 2nd Paragraph

In items 4 and 5 of the above-referenced Office Action mailed April 18, 2003, Claims 10, 25, 27, 29-33, and 35 are rejected under 35 U.S.C. § 112, second paragraph.

Applicants respectfully traverse this rejection for the reasons provided below.

Claims 25, 27, 29-33, and 35 are cancelled, rendering the rejection with respect to these claims moot. Applicants note that the Examiner recited "15" in item 5.1, when what seems to have been meant is "25."

The groups R⁴ and R⁵ appear in Claim 10 in the definitions of the groups R¹ and R² of Formula V, and thus the definitions of R⁴ and R⁵ are properly recited in Claim 10. Claim 10 is thus definite and patentable under 35 U.S.C. § 112, second paragraph.

In view of the amendments and above remarks, Applicants deem that the rejection of Claims 10, 25, 27, 29-33, and 35 under 35 U.S.C. § 112, second paragraph, has been overcome.

Claim Objections

In item 6 of the above-referenced Office Action mailed April 18, 2003, Claims 1, 3, 5, 6, 8, 10-12, 14, 16-18, 21, 25, 27, 29-33, and 35 are objected to.

Applicants respectfully traverse this objection for the reasons provided below.

Claims 11, 25, 27, 29-33, and 35 are cancelled, rendering the objection with respect to these claims moot.

Method Claims 1, 3, 5, and 18 are amended to recite osteoarthritis and MMP-13 in order to comply with the restriction requirement, rendering the objection with respect to these claims moot.

Claims 6, 8, 10 directed to compounds, Claims 12, 14, 16, and 17 directed to pharmaceutical compositions, and Claim 21 directed to treating osteoarthritis are not amended to recite osteoarthritis and/or MMP-13. There is no statutory requirement for such amendments, and thus objection to Claims 6, 8, 10, 12, 14, 16, and 17 is improper.

In view of the above amendments and remarks, Applicants deem that the objection to Claims 1, 3, 5, 6, 8, 10-12, 14, 16-18, 21, 25, 27, 29-33, and 35 is overcome.

Supplemental Information Disclosure Statement

Applicants bring to the Examiner's attention the enclosed Supplemental Information Disclosure Statement on Form PTO-1449. The Examiner is respectfully requested to consider carefully the references cited therein in connection with the examination of the above-identified application in accord with 37 CFR §1.104(a). It is believed the Examiner will concur with Applicant's belief that the subject matter presently claimed is neither claimed in nor obvious from these references. For the Examiner's convenience, a copy of PCT International Search Report citing these references in the corresponding PCT International Patent Application Number PCT/IB02/00345 is also enclosed herewith.

It is further respectfully requested that the references listed on the enclosed Form PTO-1449 be included in the "References Cited" portion of any patent issuing from this application (MPEP § 1302.12).

In view of the amendments, Applicants' above remarks, and references cited, Applicants respectfully request reconsideration of original Claims 12, 14, 16, and 21, and consideration of amended Claims 1, 3, 5, 6, 8, 10, 17, and 18, and new Claim 36. An early notice of allowability of these claims is respectfully requested.

If any additional fee is required, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to deposit account number 23-0455.

The undersigned would welcome a telephone call from the Examiner to resolve any outstanding matters in this case that the Examiner thinks are conducive to resolution by telephone.

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PCA518-01CFP

Respectfully submitted,

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Enc. (Form PTO-1449 on 2 pages and references cited therein)

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